IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
	:	
Matthias BIERBRAUER, et al.	:	Confirmation Number: 7481
	:	
Application No.: 10/020,048	:	Group Art Unit: 2178
	:	
Filed: December 14, 2001	:	Examiner: M. Ludwig
	:	

For: METHOD AND SYSTEM FOR MOVING SINGLE DOCUMENTS BETWEEN A
        DOCUMENT PROCESSING SYSTEM AND A DOCUMENT REPOSITORY

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated February 5, 2008.

        The Examiner's response to Appellants' arguments submitted in the Appeal Brief of

November 26, 2007, raises additional issues and underscores the factual and legal shortcomings

in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the

Appeal Brief of November 26, 2007, and the arguments set forth below.

1   **REMARKS**

2

3   At the outset, before addressing the Examiner's response to Appellants' arguments

4   presented in the Appeal Brief, Appellants note that the Examiner has submitted a <u>non-compliant</u>

5   <u>Examiner's Answer</u>. As is evident from the extensive comments presented by Appellants during

6   prosecution of the present Application and in the Appeal Brief, there are questions as to how the

7   limitations in the claims correspond to features in the applied prior art. In this regard, reference

8   is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the

9   following is stated:

10   (A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's
11   answer is <u>required to include</u>, under appropriate headings, in the order indicated, the following
12   items:
13   ...
14   (9)(c) For each rejection under 35 U.S.C. 102 or 103 where there are questions
15   as to how limitations in the claims correspond to features in the prior art even after the
16   examiner complies with the requirements of paragraphs (c) and (d) of this section, the
17   examiner <u>must</u> compare at least one of the rejected claims <u>feature by feature</u> with the
18   prior art relied on in the rejection. The comparison <u>must</u> align the language of the claim
19   side-by-side with a reference to the specific page, line number, drawing reference
20   number, and quotation from the prior art, as appropriate. (emphasis added)
21
22   However, upon reviewing the Examiner's Answer, Appellants note a lack of a section within the

23   Examiner's Answer that meets the requirements described in the aforementioned section. Thus,

24   the Examiner's Answer is non-compliant and further evidences the Examiner's continued failure

25   to clearly identify the features within the prior art being relied upon by the Examiner in rejecting

26   the claims and continued failure to clearly explain the pertinence of the applied prior art, as

27   required by 37 C.F.R. § 1.104(c).

28

29   Appellants have compared the statement of the rejection found on pages 3-6 of the

30   Examiner's Answer with the statement of the rejection found on pages 2-5 of the Sixth Office

1   Action. Upon making this comparison, Appellants have been unable to discover any substantial

2   differences between the respective statements of the rejection. As such, Appellants proceed on

3   the basis that the Examiner's sole response to Appellants' Appeal Brief is found on pages 10-17

4   of the Examiner's Answer.

5

6   As already alluded to above, on pages 3 and 4 of the Appeal Brief, Appellants presented

7   arguments that the Examiner has failed to fully establish the underlying facts regarding the scope

8   and content of the prior art and the differences between the claimed invention and the prior art.

9   Upon reviewing the Examiner's "Response to Argument" section on pages 6-8 of the Examiner's

10   Answer, the Examiner did not address these arguments.

11

12   As a general matter, Appellants respectfully submit that the Examiner's strategy in

13   rejecting the claims has not been to establish that the applied prior art teaches or makes obvious

14   all of the claimed limitations. Instead, the Examiner's analysis is based upon ignoring the plain

15   and ordinary meaning of certain claimed terms and construing these terms in an unreasonable

16   manner so as to assert that the applied prior art teaches these limitations. The following

17   statement is found on page 7 of the Examiner's Answer and is exemplary of the Examiner's

18   analysis:

19
20
21
22   The broad nature of the interpretation by the Examiner lends itself to the broad nature of the claim
         language. The Examiner believes the limitations of the claim are replete with language that, when
         read broadly, could be interpreted multiple ways by the reference to Hoffert reference.

23   In each instance that the Examiner asserts that the claims terms could be "read broadly" and

24   "interpreted multiple ways" the Examiner <u>fails to provide any supporting explanation</u>. Not only

25   does the Examiner not give examples as to how the claim language could be interpreted multiple

26   ways, but more importantly, the Examiner's fails to provide any <u>substantial evidence</u> for the

1　Examiner's proposed interpretation. Instead, the Examiner's analysis are conclusory statements

2　that lack factual support. Thus, the Examiner is improperly acting as a lexicographer in defining

3　the language of the claims so as to aid the Examiner in rejecting the claims.

4

5　_____

6　　　　　On pages 4-6 of the Appeal Brief, Appellants presented arguments with regard to the

7　claimed "obtaining structural information describing the structural elements of a sequential file

8　of documents in which the single document is located." Initially, the Examiner asserted the

9　following on page 6 of the Examiner's Answer:

10　　　　　　The appellant on page 5 of the appeal brief states the Examiner has failed to properly
11　identify, using the reference to Hoffert, the `structural information' describing structural elements
12　of a sequential file of documents. The Examiner believes a description of 'structural information'
13　and 'structural elements' in relation to a sequential file of documents could be found in the Hoffert
14　reference when the reference discusses the retrieval of HTML documents and the parsing of
15　specific HTML documents for media content. HTML itself is made up of *structured information*
16　based upon the markup language contained within the document and the structural elements would
17　be the tags found within the structured information. The reference provides a description of
18　'structural information' and `structural elements' within columns 3 and 4 of the reference.
19　(emphasis added)
20
21　The underlined portion of the above-reproduced passage is an example of a factually

22　unsupported and improper claim construction. As claimed, the "structural information [describe]

23　the structural elements of a sequential file of documents." To teach this structural information,

24　the Examiner is relying upon the assertion that HTML is made up of structured information.

25

26　　　　　The Examiner errs by equating information that is ordered in a structure (i.e., structured

27　information) with information about a structure (i.e., structural information). These types of

28　limitations, however, are entirely different. Structured data describes a characteristic/format of

29　the data itself (i.e., the data has a specific format). On the contrary, structural data is data that

30　describes the structure/format of something else (i.e., structural elements of a sequential file of

1   documents). Thus, the Examiner has improperly asserted that Hoffert teaches the structural

2   information, as claimed.

3

4   Moreover, as noted by Appellants on pages 5 and 6 of the Appeal Brief, the limitation at

5   issue can be split into two portions: (i) structural information is obtained that describes structural

6   elements of a file and (ii) the file is a sequential file of documents in which "the single

7   document" is located. Even *assuming arguendo* that the Examiner's analysis is correct, as

8   claimed, the structural information describes structural elements of a file of documents. Thus,

9   the structural elements describe a file (of documents). The structured information of a particular

10   HTML document describes how the data in the document is to be formatted. Thus, the teaching,

11   within Hoffert, of information used to format data within a document does not identically

12   disclose the claimed information about structural elements of a file (of documents). Therefore,

13   the Examiner has improperly characterized the underlying facts regarding the scope and content

14   of the prior art and the differences between the claimed invention and the prior art.

15

16   _____

17   In the first full paragraph on page 6 of the Appeal Brief, Appellants presented arguments

18   regarding the Examiner obviousness analysis as to the claimed "sequential file of documents."

19   In response to these arguments, the Examiner asserted the following on pages 6 and 7 of the

20   Examiner's Answer:

21   Furthermore, the phrase 'sequential file of documents' is suggested by the reference to Hoffert
22   when it describes the process of the crawler retrieving media content web pages that are stored
23   within a database. The reference mentions that the crawler begins with a seed of multimedia
24   specific URL sites for its search. See column 3, lines 29-35. The sequential file of documents, as
25   presently claimed, is suggested based upon the utilization of a database and the sequential nature
26   of storing documents. If the system looks specifically for media file types within a database then it
27   suggests a sequential file of documents being selected by a repository which one piece of content
28   at a time to be analyzed by the crawler. The Examiner interpreted the phrase 'sequential file of

documents' broadly because the there is not language defining what is meant by a sequential file of
documents. (emphasis added)

The Examiner's obviousness analysis is based upon a factually-unsupported inherency argument.

Specifically, the Examiner is relying upon "the sequential nature of storing documents." The

Examiner, however, has failed to factually establish that documents are inherently (i.e.,

necessarily) stored sequentially in a database. Instead, as would be recognized by anybody who

has run a defragging program on a hard drive, files are not necessarily stored sequentially in a

database. Instead, files are stored where space exists in the database. As documents are

deleted/modified, the available space within a database continually changes. Thus, not only are

documents not necessarily stored sequentially, a single document may be stored in different

locations.[1] Therefore, the Examiner's obviousness analysis is predicated upon an improper

inherency analysis.

The Examiner's assumption that "[i]f the system looks specifically for media file types

within a database then it suggests a sequential file of documents being selected by a repository

which one piece of content at a time to be analyzed by the crawler" is entirely factually

unsupported. Although certain of Appellants' claims are directed to sequentially stored

documents, the Examiner cannot properly assert that this is inherent within the teachings of the

applied prior art since, as already established, documents are not necessarily stored sequentially

within the prior art.

Appellants also note that the Examiner's assertion that "[t]he Examiner interpreted the

phrase 'sequential file of documents' broadly because the there is not language defining what is

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[1] See discussion at http://en.wikipedia.org/wiki/Defragmentation.

1 meant by a sequential file of documents." The Examiner, however, did not explicitly set forth

2 the Examiner's interpretation or specifically explain why the Examiner's interpretation is the

3 broadest, reasonably interpretation consistent with Appellants' specification. As to the

4 Examiner's assertion that the specification does not describe this term, reference is made to page

5 5, line 18 through page 6, line 1:

6 From a physical point of view 107, the documents 103-106 are stored sequentially within a
7 database file 108 as sequential units 109-112, indicated by different patterns.
8
9 Therefore, a proper claim construction of the phrase "sequential file of documents" should reflect

10 the notion that the documents are stored within a file, and the documents are sequentially stored

11 within the file.

12

13 _____

14 On page 6 of the Appeal Brief, Appellants argued that scanning for predetermined types

15 of HTML tags (see column 4, lines 33-34), as taught by Hoffert, does not disclose the claimed

16 "obtaining meta information describing the properties of the single document." In response to

17 these arguments, the Examiner asserted the following in the first full paragraph on page 7 of the

18 Examiner's Answer:

19 On page 6 of the appeal brief, appellant argues the limitation 'obtaining meta information
20 describing the properties of the single document'. More specifically, appellant states a heading
21 itself could be considered meta information however an HTML tag of a heading is not meta
22 information describing properties of a document. The Examiner interprets 'meta information' as a
23 type of information and believes the 'meta information' is suggested in the reference by the use of
24 HTML tags and the tags being scanned for headings suggest properties of a document. See page 4,
25 lines 31-45. The broad nature of the interpretation by the Examiner lends itself to the broad nature
26 of the claim language. The Examiner believes the limitations of the claim are replete with
27 language that, when read broadly, could be interpreted multiple ways by the reference to Hoffert
28 reference.
29
30 In the underlined portion of the above-reproduced passage, the Examiner again presents a

31 factually-unsupported and improper claim construction. By asserting that "meta information" is

1   "a type of information," the Examiner completely reads out of this claimed term the specific

2   meanings associated with this term by one having ordinary skill in the art.[2]

3

4   The Examiner's claim interpretation is contrary to how the term is used within the context

5   of the claim. Specifically, claim 1, in part, recites the following limitations:

6   obtaining meta information describing the properties of the single

7   document;

8   obtaining document content of the single document.

9

10   However, what the Examiner asserts to be meta information (see page 4, lines 31-45 of Hoffert)

11   is actually document content. Under the doctrine of claim differentiation, one having ordinary

12   skill in the art would not equate meta information with document content. Thus, the Examiner

13   has improperly characterized the underlying facts regarding the scope and content of the prior art

14   and the differences between the claimed invention and the prior art.

15

16   _____

17   On pages 7 and 8 of the Appeal Brief, Appellants several arguments with regard to the

18   last two steps (i.e., "creating …" and "transferring …") recited in claim 1. In response to these

19   arguments, the Examiner asserted the following in the paragraph spanning pages 7 and 8 of the

20   Examiner's Answer:

21   On page 7 of the appeal brief, appellant states the physical representation of the single
22   document is based upon the obtained structured information, meta information, and document
23   content. The reference to Hoffert discloses a media URL found using the crawler contains specific
24   media content which is then stored. A physical representation of the specific document stored is
25   suggested by the media content itself which is scanned and located through the use of the crawler.
26   The media content found through the scanning of HTML pages is based on the structural
27   information, meta information, and document content (media content), as discussed in the above
28   section of the Examiner's Answer. The appellant strongly disagrees with the Examiner's

_____

[2] See discussion at http://en.wikipedia.org/wiki/Meta_information.

interpretation of a 'physical representation' for the single document. However, as presently claimed, the language fails to preclude the Examiner from utilizing the reference to Hoffert to provide media content URLs stored in a repository as a physical representation of a document. The phrase 'physical representation' was objected to by the Examiner in the last office action mailed 8/24/07 because the Examiner thought the phrase left the claim open to multiple interpretations when read broadly within the scope of the invention. Thus, the broad nature of the term when read as whole within the independent claim is suggested by the Hoffert reference using media content retrieved and stored by the crawler. (emphasis added)

As previously referred to, the Examiner yet again asserts that a claims is "open to multiple interpretations when read broadly within the scope of the invention." However, the Examiner fails to provide these multiple interpretations. Although not clearly stated, the Examiner appears to be asserting that "[a] physical representation .... is suggested by the media content itself."

The inconsistency of this interpretation with the teachings of Hoffert is apparent when the Examiner asserts "[t]he media content found through the scanning of HTML pages is based on the structural information, meta information, and document content (media content)." Thus, the Examiner is asserting that media content is <u>found</u> based upon on the structural information, meta information, and document content. However, the claimed invention recites that the physical representation is <u>created</u>. Notwithstanding this fatal flaw is the Examiner's analysis, even if the Examiner intended to assert that the media content was created (i.e., corresponding to the claimed "creating a physical representation for the single document based on the obtained structural information, meta information and document content) using the media content, the question raised by the Examiner's analysis would be comparable to "what comes first, the chicken or the egg?" The Examiner is asserting that the media content is used to create the media content, which begs the question as to how the media content (which is used to create the media content) is created.

1   Notwithstanding the Examiner's factually-unsupported and internally-inconsistent claim

2   construction, Appellants note that claim 1 recites "creating a physical representation for the

3   single document based on the obtained structural information." As claimed, the "structural

4   information" regards the structural elements of a sequential file of documents. Thus, the

5   physical information of the single document not only includes meta information (about the single

6   document) and document content (of the single document), the physical information of the single

7   document includes information about data not specific to the single document itself (i.e., the

8   structural elements of a sequential file of documents). This limitation is entirely absent from the

9   teachings of Hoffert.

10

11   Regarding the claimed transferring step, Appellants presented arguments on page 8 that

12   the passage cited by the Examiner neither refers to transferring, in general, nor transferring to a

13   document repository. This argument, however, was not addressed by the Examiner in the

14   Examiner's Answer.

15

16   _____

17   On pages 8 and 9, Appellants presented arguments as to claims 5-9 and 13-17, which are

18   directed to considerably different limitations than claims 1-4. As noted in Appellants'

19   arguments, claims 5-9 and 13-17 are directed to "moving a folder and documents contained

20   therein." Claims 1-4, however, are completely silent with regard to a folder. However, the

21   Examiner did not offer a separate rejection to these claims. In response to these arguments, the

22   Examiner asserted the following in the last full paragraph on page 8 of the Examiner's Answer:

23   Appellant states on page 8, regarding the rejections of claims 5-9 and 13-17, that the
24   reference to Hoffert fails to provide any teaching or suggestion of a folder structure and
25   documents. The arguments above detail the movement of documents between a document

processing system and a document repository. The reference provides a crawler which scans for a robot exclusion protocol file. If the file is present, it indicates those directories which should not be scanned for information. On a per directory basis, there is proposed to be stored a media description file. The file contains a series of records of textual information for each media file within the current directory. The structural information obtained through document scanning is similarly retrieved through the scanning of directories. The use of directories within the reference to Hoffert suggests a folder structure and a similar retrieval of media content through directories. The Examiner recognizes that obviousness can only be established' by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 247, 21 USPQ2d 1941 (Fed. Cir. 1992). (emphasis added)

For ease of reference, the underlined portion of the above-reproduced passage is found in column 3, line 61 through column 4, line 4.

Initially, Appellants note that the Examiner has entirely mischaracterized the claims. Claims 5-9 and 13-17 are not simply reciting "a folder structure and documents." Instead, these claims are reciting a method and system for moving a folder and documents contained therein between a document processing system and a document repository. This concept is completely absent from the teachings of Hoffert.

The passage cited by the Examiner refers to a teaching of a robot exclusion file, which when read, prevents the web crawler from searching a particular directory. The relevance of these teachings to the claimed steps of obtaining structural information, obtaining meta information, creating a physical representation and transferring the created physical representation is entirely unclear to Appellants. The Examiner's analysis as to all of the claimed limitations is deficient. Therefore, the Examiner has yet again improperly characterized the underlying facts regarding the scope and content of the prior art and the differences between the claimed invention and the prior art.

For the reasons set forth in the Appeal Brief of November 26, 2007, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: April 7, 2008

Respectfully submitted,

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